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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,068	04/08/2004	Daniel J. Fisher	59692US002	9220

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EXAMINER

MORGAN, EILEEN P

ART UNIT PAPER NUMBER

3723

DATE MAILED: 12/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/821,068	Applicant(s) FISHER, DANIEL J.	
	Examiner Eileen P. Morgan	Art Unit 3723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 18 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8-8-05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Newly submitted claims 18 and 19 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: a method of manufacturing a conversion pad is a separate and distinct invention from the article claims.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 18 and 19 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-17 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Cls 1 and 7, what does the phrase 'otherwise attached to a sanding tool' mean? Refer to? What is attached? Cl. 13, is the back-up pad the same as that mentioned in cl. 1? If so, it should be 'said back-up pad'.

Art Unit: 3723

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 4,5,13 rejected under 35 U.S.C. 102(b) as being anticipated by Manor et al.-5,807,161.

Manor discloses a pad for attaching an abrasive article to a sanding tool comprising a supporting layer having a backing material (17) surrounded by a moisture barrier (12), a hook type attachment layer (14) for attaching to abrasive article, wherein the moisture barrier comprises polyurethane, which is the same material used in claimed invention and therefore would provide the same characteristics, such as barring moisture. The pad also has an opposite side for attachment to another object.

Claim Rejections - 35 USC § 103(a)

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3,6,7-12, 14,15,17 rejected under 35 U.S.C. 103(a) as being unpatentable over Manor, alone.

Manor discloses a pad for attaching an abrasive article to a sanding tool comprising a supporting layer having a backing material (17) surrounded by a moisture barrier (12), a hook type attachment layer (14) for attaching to abrasive article, wherein the moisture barrier comprises polyurethane, which is the same material used in claimed invention and therefore would provide the same characteristics, such as barring moisture. The pad also has an opposite side for attachment to another object. Manor does not disclose the backing material being vulcanized fiber board, the claimed barrier layer, the adhesive being a hot melt adhesive, or the barrier being 'coated' onto backing. However, Manor discloses using wood, fiberglass, epoxy, or impregnated canvas materials for the backing material. It would have been an obvious design choice to use material of vulcanized fiber board since these products would perform equally well and Manor discloses that the thickness can be increased or decreased to attain the desired strength and flexibility. Also, examiner takes Official Notice of the materials claimed for the barrier are functional equivalents of polyurethane in the art and the

Art Unit: 3723

choice of any would be within the level of ordinary skill. In addition, to use a hot melt adhesive would have been an obvious to one of ordinary skill in the art at time invention was made since any known adhesive capable of performing the necessary attachment would perform equally well as other attaching materials. In regard to the 'coating', this is a limitation drawn to a method of making the pad which does not further limit the pad structurally. Furthermore, examiner takes Official Notice that the way the article was made, whether 'coating the barrier unto the backing' or injection molded are functional equivalents in the art and the choice of either would be within the level of ordinary skill. In regard to claim 15, to have more than one layer or element for barring moisture would have been obvious to one of ordinary skill in the art since this would create increased protection.

5. Claim 6 rejected under 35 U.S.C. 103(a) as being unpatentable over Manor in view of Chelsey et al-5,785,784.

Manor discloses a pad for attaching an abrasive article to a sanding tool comprising a supporting layer having a backing material (17) surrounded by a moisture barrier (12), a hook type attachment layer (14) for attaching to abrasive article, wherein the moisture barrier comprises polyurethane, which is the same material used in claimed invention and therefore would provide the same characteristics, such as barring moisture. The pad also has an opposite side for attachment to another object. Manor does not disclose the adhesive being a hot melt adhesive. However, Chelsey (col. 8, line 43) teaches a hot melt adhesive is sufficient bonding for hooking stems to be attached to a second major surface. Therefore, it would have been obvious to one of ordinary skill in the art at time invention was made, as taught by Chelsey (col. 8, line 43) to use a hot melt adhesive for bonding hooking stems to a second major surface in order to securely affix fasteners to backing material.

6. Claim 16 rejected under 35 U.S.C. 103(a) as being unpatentable over Manor in view of Edinger-6,394,887.

Manor discloses a pad for attaching an abrasive article to a sanding tool comprising a supporting layer having a backing material (17) surrounded by a moisture barrier (12), a hook type attachment layer (14) for attaching to abrasive article, wherein the moisture barrier comprises polyurethane, which is the same material used in claimed invention and therefore would provide the same characteristics, such as barring moisture. The pad also has an opposite side for attachment to another object. Manor does the pad having attachment means (14) on both sides to attach to objects, but does not disclose the pad being without holes. However, Edinger teaches a pad for attachment to two opposed objects without holes. Therefore, it would have been obvious to one of ordinary skill in the art at time invention was made to use a pad, such as disclosed by Manor, without holes, as taught by Edinger, to have a continuous, uninterrupted attachment surface. In addition, to have holes or not, would be an obvious design expedient dependent on working parameters.

Response to Arguments

Applicant's arguments filed 10-13-05 have been fully considered but they are not persuasive. Applicant argues that Manor does not disclose a 'conversion pad'. Manor discloses a pad with two attachment surfaces. The pad is capable of being attached to another pad, such as a 'back-up' pad. The term 'conversion' and the use 'for attaching to a back-up pad' is merely describing its intended use and does not further limit the claim structurally. Manor discloses a pad used in a sanding system capable of being used as a 'conversion' pad and having the claimed limitations or having obvious limitations alone or in view of another teaching reference, as discussed above. In regard to the moisture barrier, element 12 of Manor reads on this limitation and is composed of the same material (polyurethane) which would exhibit the same characteristics, such as barring moisture. The choice of the backing material would be obvious to one of ordinary skill in the art. In regard to claims 14 and 17, the intended manor in which the pad is made, barrier coating or molded coating would be an obvious design expedient. In regard to cl. 16, to have holes or not is a design preference and not a patentable feature. Claims 18 and 19 have been withdrawn from consideration since these claims are drawn to a patentably distinct invention.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eileen P. Morgan whose telephone number is 571.272.4488. The examiner can normally be reached on Tuesday-Thursday (Office), Friday (Work at home).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 571.272.4485. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3723

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EM
December 21, 2005

A handwritten signature in black ink, appearing to be 'EPM', with a long horizontal line extending to the right.

EILEEN P. MORGAN
PRIMARY EXAMINER